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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,758	09/23/2005	Young Ok Kim	58049-00019	1382

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EXAMINER
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RAGHU, GANAPATHIRAM

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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05/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/550,758	Applicant(s) KIM ET AL.	
	Examiner Ganapathirama Raghu	Art Unit 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-16 and 18-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-10, 12-14 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 3, 6, 7, 11, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/19/06</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***Application Status***

In response to the Office Action mailed on 10/11/2006, applicants' filed a response and amendment received on 03/30/2007. Said amendment, amended claims 1-3, 6-8, 15-16 and 18-19, and cancelled claim 17. Thus, claims 1-3, 5-16 and 18-20 are pending in the instant Office Action and are now under consideration.

Objections and rejections not reiterated from previous action are hereby withdrawn.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 06/19/06, is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the IDS statement.

***Withdrawn- Claim Rejections 35 USC § 101***

Claims 6-8, 10-11, and 15-19 rejected under 35 U.S.C. 101 are withdrawn in view of the applicants' cancellation of claim 17 and amendment of claims 6-8, 10-11, 15-16 and 18-19.

***Withdrawn- Claim Rejections 35 USC § 112***

Claims 1-3, 5-16 and 18-20 rejected under 35 U.S.C. 112, second paragraph are withdrawn in view of the applicants' cancellation of claim 17 and amendment of claim 1.

***Withdrawn- Claim Rejections 35 USC § 112***

Claims 1-3, 5-16 and 18-20 rejected under 35 U.S.C. 112, first paragraph are withdrawn in view of the applicants' cancellation of claim 17 and amendment of claims 1 and 6 and submission of an affidavit regarding the biological deposit.

***Withdrawn- Claim Rejections 35 USC § 102***

Claims 1-3, 5, 8-14 and 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Kim et al., (Biotechnol. Letters., 2003, Vol. 25: 1231-1234), in view of submission of English

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language translation of the foreign priority document, Korean Application 10-2003-0018573 filed on March 25, 2003.

***Withdrawn- Claim Rejections 35 USC § 103***

Previous rejection of claim 6 is rejected under 35 U.S.C. 103(a) as being obvious over Kim et al., (Biotechnol. Letters., 2003, Vol. 25: 1231-1234) is withdrawn in view of submission of English language translation of the foreign priority document, Korean Application 10-2003-0018573 filed on March 25, 2003.

***Claim Objections***

Claims 3 and 7 are objected to, due to the following informality: Claims 3 recites the phrase "a polypeptide" and claim 7 recites the phrase "a polynucleotide" in the claims. Examiner suggests changing the phrase to "the polypeptide" and "the polynucleotide", appropriate correction is required.

Claims 15-16 are objected to, due to the following informality: Claims 15-16 recites the phrase "coding" in the claims. Examiner suggests changing the phrase to "encoding", appropriate correction is required.

***New-Claim Rejections 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3, 5, 8-10, 12-14 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al., (2002) when given the broadest interpretation. Claims 1-3, 5, 8-10, 12-14 and 18-20 are directed to an isolated polypeptide from *Citrobacter braakii* YH-15 strain, said polypeptide comprising amino acid residues 23-433 of SEQ ID NO: 7 and having phytase activity with a specific activity of said polypeptide to phytate is at least 3,000 units/mg, and a feed additive comprising said polypeptide. Kim et al., (*supra*) disclose the isolation and characterization of a phytase polypeptide from *Citrobacter braakii* YH-15 strain with exactly the same physico-chemical, biochemical properties and having phytase activity with a specific activity of said polypeptide to phytate is 3,457 units/mg to the protein of the instant invention, and the commercial use of polypeptide with phytase activity as feed additive (see Abstract in IDS). Said reference is silent regarding the isolated polypeptide comprising amino acid residues 23-433 of SEQ ID NO: 7, however examiner takes the position that the source of the reference polypeptide is the same as the instant invention and therefore the reference polypeptide and the polypeptide of the instant invention are one and the same and the reference polypeptide inherently possess the amino acid residues 23-433 of SEQ ID NO: 7 of the instant invention.

Since the Office does not have the facilities for examining and comparing applicants' protein with the protein of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the protein of the prior art does not possess the same material structural and functional characteristics of the claimed protein). See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 205 USPQ 594.

*Conclusion*

None of the claims are allowable.

*Summary of Pending Issues*

The following is a summary of issues pending in the instant application.

- 1) Claims 3, 7 and 15-16 are objected to, due to informality.
- 2) Claims 1-3, 5, 8-10, 12-14 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al., (2002) when given the broadest interpretation.
- 3) Claims 6, 7, 11 and 15-16 are objected as they depend from rejected base claims.

*Final Comments*

To insure that each document is properly filed in the electronic file wrapper, it is requested that each of amendments to the specification, amendments to the claims, Applicants' remarks, requests for extension of time, and any other distinct papers be submitted on separate pages.

It is also requested that Applicants identify support, within the original application, for any amendments to the claims and specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathirama Raghu whose telephone number is 571-272-4533. The examiner can normally be reached on M-F; 8:00-4:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of the application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ganapathirama Raghu, Ph.D.  
Patent Examiner  
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May 01, 2007.

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1652